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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,321	03/13/2001	Scott A. Hermreck	580745.004	1791

758 7590 03/28/2007  
FENWICK & WEST LLP  
SILICON VALLEY CENTER  
801 CALIFORNIA STREET  
MOUNTAIN VIEW, CA 94041

EXAMINER
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LANEAU, RONALD

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/805,321

Applicant(s)

HERMRECK ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-29 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7-20,23-29,40-49 is/are rejected.
- 7) ☒ Claim(s) 3-6,21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Response to Amendment***

1. The response filed on 1/11/07 has been entered. Claims 1, 3-29, 40-49 remain pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 7-20, 23-29 and 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price (US 2002/0120539 A1) in view of Hodges (US 2002/0116290 A1) and further in view of TurboTax.

As per claims 1, 8-22, 24-29, 40-44, 48 and 49, Price discloses a computer-implemented method for tracking charitable donations, said method comprising the steps of: storing in memory data indicative of one or more non-cash donatable items (page 2, [0020]); prompting a user to select one or more of said non-cash donatable items that has been charitably donated in one of said tax years and to indicate the tax year in which the selected non-cash donatable item was donated (page 4, [0035] – [0036]). Price does not explicitly disclose a valuation of non-cash donation but Hodges discloses a valuation associated with each said non-cash donatable item for a current tax year and at least one previous tax year (page 1, [0007]). Neither Price nor Hodges discloses importing the valuation but TurboTax discloses an available means of electronically retrieving the tax-deductible valuation associated with said selected non-cash donatable item for the indicated tax year from memory (inherent in importing data, page 12); and storing said

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selected non-cash donatable item, indicated tax year and retrieved tax-deductible valuation in said memory in association with each other (from the system's server memory).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system of valuating non-cash donation as taught by Hodges into the system of Price because it would facilitate the donations of IP assets (non-cash donation) from potential donors to potential donees. And it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system of importing data from memory as disclosed in the Turbo book into the system of Price because it would make tracking tax records easier.

As per claims 7, 23, 45 and 47, the above rejection applies. Furthermore, Price discloses a computer-implemented method further comprising the step of updating said memory with a current set of data indicative of said one or more non-cash donatable items and a current tax-deductible valuation associated with said donations; presenting the user with informative data based upon said non-cash donatable items selected by the user (see abs, page 4, [0035] – [0036]). Price does not explicitly disclose exporting the category totals electronically into an income tax return but TurboTax an available means of electronically retrieving retrieving the tax-deductible valuation associated with said selected non-cash donatable item for the indicated tax year from memory (inherent in importing data, page 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system of importing data from memory as disclosed in the Turbo book into the system of Price for the same reasons given above.

*Allowable Subject Matter*

4. Claims 3-6, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the references, either singularly or in combination, discloses or even suggests:

As per claims 3 and 4, a computer-implemented method further comprising: receiving sales data periodically from one or more partner servers, wherein said partner servers are programmed to electronically collect sales data of items sold; and calculating a tax-deductible valuation in accordance with tax authority guidelines for each of said non-cash donatable items based on said sales data.

As per claims 5 and 6, a computer-implemented method of claim 1, further comprising the steps of: totaling the tax-deductible valuations associated with all non-cash donatable items for the tax year in categories based upon non-cash item, monetary, mileage, financial securities and out-of-pocket donations; and exporting the category totals electronically into an income tax return for said tax year.

As per claims 21 and 22, a computer-implemented method further including the steps of: receiving periodically an aggregation of sales data from one or more partner servers, herein said partner servers having at least one data source where items are sold; calculating a current tax-deductible valuation for said plurality of items; and updating said memory with said current tax-deductible valuation for said plurality of items.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 3-29 and 40-49 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the examiner fails to make a prima facie case of obviousness since there is no suggestion or motivation to modify the references or combine reference teachings so as to arrive at the claimed invention. In response to applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Claims 1, 3-29, 40-49 remain rejected. Applicant further argues that neither Price nor Hodges discloses "storing memory data indicative of one or more non-cash donatable items and a tax-deductible valuation associated with each said non-cash donatable item for a current tax year and at least one previous tax year." In response to Applicant's arguments, Turbo Tax is used to disclose such features because it stores valuation of non-cash donatable items for tax payers in their system so that previous year can be imported together with information about the current year. Furthermore, Applicant argues that the Examiner did not demonstrate the presence of a motivation to combine the references or a reasonable expectation of success in the references. In response to Applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

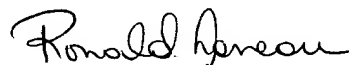
knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ronald Laneau  
Primary Examiner  
Art Unit 3714

3/19/07

